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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,777	07/29/2005	Marcus Steen	00009-007	5856

44012 7590 12/13/2006

WHITE, REDWAY & BROWN LLP  
1217 KING STREET  
ALEXANDRIA, VA 22314

EXAMINER
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LE, DAVID D

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/526,777		STEEN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	David D. Le		3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/08/05</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is the first Office action on the merits of Application No. 10/526,777, filed 29 July 2005. Claims 1-6 are pending.

#### **Documents**

2. The following documents have been received and filed as part of the patent application:
  - Information Disclosure Statement, received on 03/08/05
  - Declaration and Power of Attorney, received on 07/29/05
  - Copy of the Certified Copy of Foreign Priority Document, received on 03/08/05

#### ***Specification***

3. The disclosure is objected to because of the following informalities:
  - Page 1, lines 7-8, "according to the preamble of patent claim 1 below" should be deleted for at least two reasons as follows:
    - First, the present claim 1 has not been patented; and
    - Second, it is unclear whether the present specification is referring to the original claim 1 or the currently amended claim 1.
  - Page 3, lines 9-14, "The solution of the problem according to the invention as far as the device according to the invention is concerned is described in patent claim 1. the other patent claims described preferred embodiments and developments of the device according to the invention (2 and 3)." should be deleted for at least two reasons as follows:

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- First, the present claims have not been patented; and
  - Second, it is unclear whether the present specification is referring to the original claims or the currently amended claims.
- Page 4, lines 10-11, "Further embodiments of the invention emerge from the subsequent dependent patent claims." should be deleted for at least two reasons as follows:
  - First, the present claims have not been patented; and
  - Second, it is unclear whether the present specification is referring to the original claims or the currently amended claims.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 1:**

- Line 4 recites the limitation "the gears". There is insufficient antecedent basis for this limitation in the claim.
- Line 4 recites the limitation "neutral position". It is unclear whether the limitation is referring to the neutral position of the basic gearbox or the auxiliary gear.

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- Line 4 also recites “disengagement of the gears of the gearbox and also neutral position”. It is also unclear whether there is a difference between the claimed “disengagement of the gears of the gearbox” and the claimed “neutral position” of the gearbox.
- Lines 5-6 recite the limitation “neutral position”. It is unclear whether this neutral position is for the basic gearbox or the auxiliary gear.
- Line 7 recites the limitation “neutral position”. It is unclear whether this neutral position is different from the one, which is first recited on line 4 of the claim.

Claim 2:

- Lines 3-4 recite the limitation “while the neutral position is occupied”. It is unclear whether the claimed limitation is referring to the neutral position of the auxiliary gear or the basic gearbox.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by WO**

**01/92049 A1 (WO'049).**

Claims 1-6:

WO'049 (Figs. 1-2; pages 1-9) discloses a gearbox (i.e., Fig. 2, element 9) comprising:

- An unsynchronized basic gearbox (i.e., Fig. 2, being combination of elements 15, 17-26, 28-30, and 41-43);
- A synchronized split gear section (i.e., Fig. 2, being combination of elements 12-17 and 40);
- A synchronized range section (i.e., Fig. 2, vicinity of element 32);
- An electronic control unit (i.e., Fig. 1, element 45);
- An electronic gear selector (i.e., Fig. 1, element 46);
- Wherein the control unit controls engagement and disengagement of the gearbox (i.e., page 5, line 17 – page 7, line 3);
- Wherein the control unit is arranged so as, when input signals indicating that neutral position is selected are received, to put the at least one of the synchronized split gear section and range section in neutral position (i.e., page 5, line 29 – page 6, line 9); and
- Wherein the control unit is arranged so as in the basic gearbox, a previous selected gear engaged while the neutral position of the auxiliary gear occupied (i.e., page 5, line 29 – page 6, line 9).

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

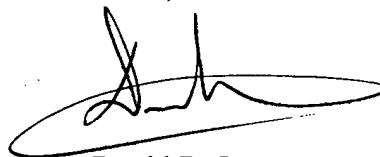
- G. C. E. Galicher (U. S. Patent No. 3,429,202) teaches a gearbox, as shown in Fig. 1.
- Borodin et al. (U. S. Patent No. 4,986,142) teaches a compound transmission, as shown in Fig. 1.
- Newbigging (U. S. Patent No. 5,791,189) teaches a compound transmission, as shown in Fig. 1.
- Pigozzi et al. (U. S. Patent No. 6,250,172) teaches a gear change for a commercial vehicle, as shown in Fig. 1.
- Nishimura (U. S. Patent Application Publication No. US 2001/0025536 A1) teaches an automatic transmission, as shown in Fig. 3.
- Stauber et al. (U. S. Patent No. 6,440,032) teaches a transmission, as shown in Fig. 1.
- Fuhrer et al. (U. S. Patent No. 6,709,356) teaches a transmission, as shown in Fig. 1.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0700-1530).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'David D. Le', enclosed within a large, horizontal, oval-shaped scribble.

David D. Le  
Examiner  
Art Unit 3681  
12/10/06

ddl